

REMARKS/ARGUMENT

Description of amendments

Claims 1, 8-10, and 13 are now pending and under examination. Applicant has amended 10. No new matter has been added.

Rejection under 35 U.S.C. §112, first paragraph

The rejection of claims 10 and 13 under 35 U.S.C. §112, first paragraph, has been overcome by the amendment to claim 10.

Rejection under 35 U.S.C. §102

Claims 10 and 13 were rejected under 35 U.S.C. §102(b) as being anticipated by Davidson (U.S. Patent 5,591,329). For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection.

Davidson shows a filter in which several spacers (81) are placed axially inside the filter. Also, to install the spacers (81), the end caps (68 and 70) must be removed. Additionally, the spacers 81 serve a filtering function and have no additional purpose corresponding to the functional part of Applicants' invention.

Further, the lateral recess of claim 10, as amended, comprises a spacing that is between two adjacent pleats and is arranged outside of the annular filter medium, and the spacing is larger than other similar spacings that also are outside of the annular filter medium and between other two adjacent pleats. Such a lateral recess is not taught or suggested by Davidson. In fact, the spacings in Davidson appear to be identical (see, for example, Figure 7A).

Accordingly, claims 10 and 13 are not anticipated by Davidson.

Rejection under 35 U.S.C. §103(a)

Claims 1, 8, and 9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Richardson (U.S. Patent 5,213,682) in view of Davidson and Weber (U.S. Patent 4,610,848). For any one of the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection.

As discussed above, Davidson shows a filter in which several spacers (81) are placed axially inside the filter. In Applicants' invention, the functional part is placed outside of the filter medium. Also, to install the spacers (81), the end caps (68 and 70) must be removed. Further, the spacers 81 serve a filtering function and have no additional purpose corresponding to the functional part of Applicants' invention.

Richardson shows a filter in which a functional element extends into the center of a filter. It does not teach mounting a functional element outside of the filter medium.

One of the reasons, based on which Applicant requests reconsideration of the rejection, is that the Examiner has not established that it is obvious to modify the filter of Richardson according to the teachings of Davidson. (Accordingly, there is no need to discuss whether it is proper to further modify the filter of Richardson according to the teachings of Weber.) Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under §103(a) requires, *inter alia*, consideration whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed invention. See *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). The Examiner contended that it is considered obvious to modify the filter of Richardson according to the teachings of Davidson. However, the Examiner has failed to point out where in the prior art exists the suggestion to combine the teachings of Richardson and

Davidson. The Examiner's contention alone, without the required suggestion, is insufficient to justify the obviousness rejection. The Examiner further contended that the combination has various advantages. However, even if the alleged advantages are true, they cannot serve as the required suggestion if they have not been mentioned in the prior art.

A second reason, based on which Applicant requests reconsideration of the rejection, is that, assuming, *arguendo*, that the Examiner had established a prima facie case of obviousness, the prima facie case can be rebutted. A prima facie case of obviousness can be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. In *re Geisler*, 116, F3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). In the present case, Richardson teaches away from combining the teachings of Richardson, Davidson and Weber. In Richardson, the filter unit (7) is threadedly mounted to the filter mount (1). To remove or install the filter unit (7), it must be rotated relative to the filter mount (1). If a functional element were mounted laterally in the filter unit (7), the filter unit (7) could no longer be removed or installed for the purpose of replacement, because the laterally installed functional element would prevent the filter unit from rotating. Although the functional element can be removed before removal or installation of the filter unit (7), such a procedure is cumbersome and time-consuming. Therefore, Richardson teaches, indeed it requires, that the functional element be installed through the center of the filter unit. Accordingly, a person with ordinary skill in the art would not have mounted a functional element laterally in the filter unit (7).

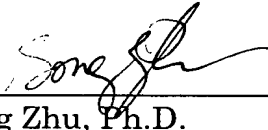
In light of the foregoing remarks, this application is considered to be in condition for allowance, and early passage of this case to issue is respectfully requested. If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

Application No. 09/881,043
Reply dated June 14, 2004
Response to Office Action dated March 12, 2004

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #037141.50052US).

June 14, 2004

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Song Zhu', is written over a horizontal line.

Song Zhu, Ph.D.
Registration No. 44,420
J. D. Evans
Registration No. 26,269

CROWELL & MORING LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
JDE:SZ:tlm (037141.50052US; 323564)